



PATENT
Docket No. 1752-0151P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Akio INOUE et al. CONF.: 8894
APPLN. NO.: 09/983,067 GROUP: 1614
FILED: October 23, 2001 EXAMINER: Unknown
FOR: PROCSESS FOR PRODUCING PEPTIDES BY USING IN VITRO
TRANSCRIPTION/TRANSLATION SYSTEM

RESPONSE

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

In response to the Notice (Form PTOL-456) dated February 4, 2002, received in the matter of the above-identified application, enclosed herewith is a Statement setting forth the full facts concerning the circumstances under which the invention was made and the relationship of the invention to the performance of any work under any contract with the Department of Energy (DOE) or the National Aeronautics and Space Administration (NASA). A copy of the Notice is also attached.

Applicants believe that the attached Statement is sufficient for responding to the Notice. If any further information is required, the USPTO is requested to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

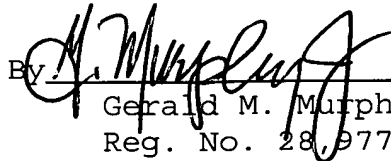
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required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  _____
Gerald M. Murphy, Jr.
Reg. No. 28,977

P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000

GMM/las
1752-0151P

Attachments:
Statement
Notice (Copy)



Docket No. 1752 - 0151P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Akio INOUE et al.
APPLN. NO. : 09/983,067
FILED : October 23, 2001

CONF. : 8894
GROUP : 1614
EXAMINER : Unknown

FOR : PROCESS FOR PRODUCING PEPTIDES BY USING IN
VITRO TRANSCRIPTION/TRANSLATION SYSTEM

STATEMENT

Assistant Commissioner of Patents
Washington, DC 20231

Sir:

We, Akio INOUE, a citizen of Japan, residing at B - 101, Sunny Hill, 16 - 13, Atago 2 - chome, Ageo - shi, Saitama, Japan;

Yoshihiro SHIMIZU, a citizen of Japan, residing at No. 407, 31 - 10, Hatagaya 3 - chome, Shibuya - ku, Tokyo, Japan; and

Takuya UEDA, a citizen of Japan, residing at 4 - 204, Tokyo Univ. Syukusya, 1 - 170, Yayoicho, Inage - ku, Chiba - shi, Chiba, Japan, declare that :

1. We made and conceived the invention described and claimed in U.S. Patent Application No. 09/983,067 filed in the United States of America on October 23, 2001.
2. We made and conceived the invention in the course of our research activities at the University of Tokyo. The invention was assigned to Post Genome Institute Co., Ltd.
3. To the best of our knowledge and belief, the invention was not made in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors : Energy Research and Development Administration or the Department of Energy.
4. The invention was not made (conceived or first actually reduced to practice) under nor is there any relationship of the invention to performance of any work under any contract of the National Aeronautics and Space Administration.

5. The undersigned inventors declare further that all statements made herein of my own knowledge are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

By : Akio Inoue Date : March 9, 2002
Akio INOUE

B - 101, Sunny Hill, 16 - 13, Atago 2 - chome, Ageo - shi,
(insert post office address)

Saitama, Japan

By : Yoshihiro Shimizu Date : March 12, 2002
Yoshihiro SHIMIZU

No. 407, 31 - 10, Hatagaya 3 - chome, Shibuya - ku, Tokyo, Japan
(insert post office address)

By : Takuya Ueda Date : March 12, 2002
Takuya UEDA

4 - 204, Tokyo Univ. Syukusya, 1 - 170, Yayoicho, Inage - ku,
(insert post office address)

Chiba - shi, Chiba, Japan

POCKETED
Response
3-21-02



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/983,067	10/23/01	INOUE, ET AL.	1752-0151P

BIRCH STEWART KOLASCH & BIRCH
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
ART UNIT	PAPER NUMBER
	3

PATENT & TRADEMARK OFFICE

DATE MAILED: MAILED

FEB 4 2002

LICENSING & REVIEW

**IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A
FORMAL REQUIREMENT WILL BE ISSUED**

The subject matter of this application appears to:

- ☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).
- ☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

Accordingly, no patent can issue on this application unless applicant(s) file a statement (under oath or in the form of a declaration as provided by 37 CFR 1.68) setting forth (1) the full facts concerning the circumstances under which the invention was made and conceived and (2) the relationship (if any) of the invention to the performance of any work under any contract or other arrangement with the Agency(ies) noted above. On the reverse side of this form is an example of an acceptable format for this statement. The language appearing in paragraphs III and/or IV of the example *must* appear if applicant is attempting to establish that no relationship (under item 2 above) exists.

If the invention disclosed in this application was developed under a contract, grant or cooperative agreement between the Agency indicated above and a person, small business or non-profit organization and rights to the invention have been determined by specific reference to 35 U.S.C. 202 in the contract, grant or cooperative agreement, then applicant need not submit the statement described above. Instead, applicant may file a verified statement (under oath or in the form of a declaration, 37 CFR 1.68) setting forth the information required by 35 U.S.C. 202(c)(6).

IF NO STATEMENT HAS BEEN RECEIVED WITHIN FORTY-FIVE DAYS OF THE MAIL DATE INDICATED ABOVE, a formal requirement for statement will then be issued. No provision is made for extension of the statutory thirty-day period for response to the formal requirement and the penalty for failure to file an acceptable and timely statement is abandonment of the application. Therefore, applicants are strongly encouraged to submit a statement at this time in order to avoid the issuance of a formal requirement.

IT IS IMPORTANT TO NOTE that the statement must accurately represent the property rights situation of the claimed invention if and when the application is found allowable. Thus, if during prosecution before the examiner, the claimed invention is so altered or the property rights situation so changed as to impact the accuracy of a statement submitted earlier, a supplemental statement must be filed. Failure to submit such additional information where appropriate may be considered a false representation of material facts and render the patent owner vulnerable to loss of patent rights and other sanctions as set forth in the statutes. The PTO will not review allowed applications for this possibility. The responsibility for complying with the statutes rests with the applicants.

Any questions regarding this requirement should be directed to Licensing and Review at (703) 306-4191.

**PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE
ATTENTION OF LICENSING AND REVIEW**